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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,859	09/09/2003	Larry D. Humlicek	58878US002	2059
32692	7590	01/23/2006		
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER RAO, G NAGESH	
			ART UNIT	PAPER NUMBER

1722

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/657,859	HUMLICEK ET AL.	
	Examiner	Art Unit	
	G. Nagesh Rao	1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 12-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1) Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-11, drawn to an apparatus, classified in class 425 subclass 174.4.
- II. Claims 12-22, drawn to a method, classified in class 264, subclass 284.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used to practice another and materially different process such as cutting and separating the web if the pattern includes a die.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Rick Franzen on 6/21/05 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2) Claims 1-11 rejected under 35 U.S.C. 102(b) as anticipated by Prix (WO 98/52733).

Please note the examiner is using reference Prix (US Patent No. 6,495, 214) as an English equivalence to Prix (WO 98/52733).

Prix 214 depicts an apparatus setup in Figures 1-3, where there is a roller 17 having a lenticular structure and roller 19 having a bar structure both of which read on as types of patterned rollers, and there being a means for rotating the rollers such that their patterns are capable of being transferred to opposite sides of the web

in a continuous motion, whereby its capabilities are directed towards patterning the film material on both sides with registration of each other and patterned rollers (See Abstract, Col 3 Lines 6-13 and Col 4 Lines 51-59).

The patterned rollers are conceivably and inherently capable to one skilled in the art to transferring patterns to opposite sides of the film from within 100 to 5 microns. This is based on examiner's interpretation of the means plus function language governed by applicant's specification. Where applicant's have claimed the use of an encoder system to operate and allow for a web registration to occur by both rollers to transferring patterns to opposite sides of the film from within 100 to 5 microns. This is enabled by the fact that the motors are coupled to one another via an electronic synchronism control, utilizing coupled gear transmissions and the tachometers (reading on as a type of encoder) which supply the actual speed of the rollers, makes it possible to achieve very accurate synchronism control (See Col 5 Lines 42-68 and Col 6 Lines 1-35).

Furthermore Prix 214 teaches the apparatus capable of dispensing a castable polymeric material which would later on be cured, and there being a first dispenser means being nip 16 for relaying the film material to roller 17 which is then transferred to nip 18 being a second dispenser for relaying the film to roller 19. Finally throughout the course of the apparatus, the film material is cured via a

radiant energy source 22 capable of emitting heat and light since that source being a UV light and given the known state of art capable alternative energy and light sources include but not limited to being infrared and visible sources (See Col 5 Lines 1-17 and Col 9 Lines 1-55).

Conclusion

3) Applicant's arguments filed 11/14/05 have been fully considered but they are not persuasive. It is the examiner's position based on the aforementioned rejection that Prix 214 teaches the elements claimed by applicant. The patterned rollers (17,19), means for rotating the first and second patterned rollers (Col 5 Lines 42-68 and Col 6 Lines 1-43), where the maintaining of the continuous registration on said opposite sides of the web to within 100 – 5 microns is capable of being achieved by the technology incorporated by Prix 214's spec. Finally the apparatus is capable of dispensing a castable polymeric material through the rollers that can later on be heat treated and cured via the radiant energy source (22) a UV light.

4) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to G. Nagesh Rao whose telephone number is (571) 272-2946. The examiner can normally be reached on 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GNR



ROBERT DAVIS
PRIMARY EXAMINER
GROUP 1300
1/19/06